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REMARKS

Claims 13-18 and 31 are in this application with claims 13, 14, 15, 17, and 31 amended, and claims 19-30 cancelled herein. No new matter is added by this amendment.

Initially, the office action objects to claims 19 and 31 for certain informalities. Claim 19 is cancelled and claim 31 is amended herein to obviate the objection. Withdrawal of these objections is requested.

On the merits, claims 19-22 and 24-26 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 1,235,801 to Horning. These claims are cancelled herein, thus it is submitted that this rejection is now moot.

Claims 13-18, 23, and 29-31 are rejected under 35 U.S.C. § 103(a) as unpatentable over Horning in view of U.S. Patent No. 5,884,408 to Simmons.

As an initial matter, it is submitted that independent claims 13 and 31 patentably distinguish over the relied upon portions of Horning and Simmons whether used alone or in combination. Contrary to the assertion in the office action, Horning does not show a first set of indicia on one side of a tape and a second set of indicia on a second side of a tape. As the term side is used in the instant application, for example paragraph [0025] of the published application, a side refers to the viewable surface of a plan view of the tape. Thus, as used in the claims side refers to the flat surfaces of the tape when viewed from a top plan view and a bottom plan view respectively. The second side is not viewable when viewing the first side. The relied upon portions of Horning teach only indicia appearing on left and right edges of the ruler when viewed from a plan view, as shown in Fig. 1. Similarly, Simmons only shows indicia and markings on the edges of the tape shown therein. Accordingly, it is submitted that the relied upon portions of

Horning and Simmons do not teach or suggest indicia formed on the first and second sides of the tape and recited in independent claims 1 and 31.

Next, MPEP 2143 lists three separate requirements for establishing prima facie obviousness:

1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
2. Second, there must be a reasonable expectation of success.
3. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As an initial matter, as discussed above, each and every element of the claims cannot be found in the cited references.

Second, there is no specific teaching in Horning that the carpenters ruler shown therein could be placed on a tape measure. Further, there is nothing in Simmons that would suggest using the tape shown therein to display architects scales.

The Federal Circuit has held that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Further, a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*,

28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). ; see also *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (holding the level of skill in the art cannot be relied upon to provide the suggestion to combine references).

The office action alleges only that Simmons teaches rulers and tape measures are alternative means for measuring objects. It is submitted that this statement standing alone does not provide motivation to combine the very specific application of an architects rule to a tape measure, rather only that both a tape and a ruler can measure distances. At best, it is submitted that this statement provides a reasonable expectation of success, but does not specifically provide the motivation to combine as alleged in the office action.

Indeed, it appears that the only actual motivation to combine an architects rule with a tape measure is found in the instant application. However, reliance on such a teaching is improper and subsequent combinations appear to have been made with improper hindsight.

Still further, the office action's establishment of the alleged *prima facie* case of obviousness does not consider the instant invention's addressing of a long felt need. As outlined by the background of the invention, architect's rules have been known and used in the industry for some time. The problem with such a device is that it is limited in length and does not enable a user to both measure the scaled size of a drawing and transpose that scaled dimension to a physical structure to be measured and worked upon using a single device. Since architects rules are generally only 1 foot in length, they are not equipped for measuring large objects as a tape measure can. Accordingly, to use the known devices a builder has to first measure a dimension on a plan using the architects rule at the desired scale ratio and then use a separate device to measure the desired distance on the object or material worked upon. Thus, the present invention addresses the long felt need of a single device for both measuring scaled plans and for measuring

objects and material to be worked. This need has long been felt by those in the building trades and the use of the present invention both simplifies the tasks and helps to guarantee accuracy. This need has not been satisfied by prior tape measurement devices, and this invention clearly satisfies that need. Accordingly, it is submitted that the long felt need the instant invention addresses demonstrates the secondary considerations necessary to rebut a case of *prima facie* obviousness as outlined in the office action.

For at least the foregoing reasons, it is submitted that the invention as claimed in independent claims 1 and 31 patentably distinguish over the relied upon portions of Horning and Simmons whether alone or in combination. Further, it is submitted that the combination suggested in the office action fails to set forth a *prima facie* case of obviousness as there is no motivation to combine the references and the level of ordinary skill in the art cannot provide such motivation. Still further, it is believed that the combination evidences improper hindsight. Finally, it is submitted that to the extent a *prima facie* case of obviousness has been established the secondary consideration, addressing a long felt need, overcomes this case of obviousness.

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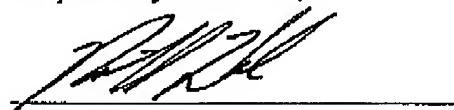
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Conclusion

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper, including any necessary extension fees, may be charged on Deposit Account 50-1290.

Respectfully submitted,



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